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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,546	02-09-2001	Fredrik Wernersbe	2001_0142A	5779

7590

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EXAMINER

FERGUSON, LAWRENCE D

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,546

Applicant(s)

WATANABE ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 9, 14 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB-068)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed March 11, 2004.

Claims 1 and 4-9 are amended and claims 2-3 were cancelled rendering claims 1, 4-14 and 19 are pending in this case.

Claim Rejections – 35 USC § 103(a)

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-8 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over March et al. (U.S. 5,937,521).

March discloses elongated plastic members (column 2, line 48) where metal (20) is covered by a plastic shell (18) and a plastic core (12) comprised of suitable thermoplastic resins such as polyolefins, including polyester (column 4, lines 59-67). The reference discloses steel (metal) is coated with the well-known coatings (column 5, lines 44-45) where the plastic members are cut into predetermined lengths (abstract), giving the plastic members different elongations. In instant claims 7-8, the limitation of oxygen permeability being less than $10^{-11} \text{cm}^3 \text{cm/cm}^2 \cdot \text{sec} \cdot \text{cmHg}$ and

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$10^{-12} \text{cm}^3/\text{cm}^2 \cdot \text{sec} \cdot \text{cmHg}$ is met by March, because less than $10^{-11} \text{cm}^3/\text{cm}^2 \cdot \text{sec} \cdot \text{cmHg}$ and $10^{-12} \text{cm}^3/\text{cm}^2 \cdot \text{sec} \cdot \text{cmHg}$ includes zero. In instant claim 1, the phrase, "for car body" is an intended use, which is given little patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). With regard to the limitations of the amount of rate of elongation and thickness of the plastic films, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. rate of elongation and thickness) fails to render claims patentable in the absence of unexpected results. All of the aforementioned limitations are optimizable as they directly affect the durability and mechanical strength of the plastic covered metal. As such, they are optimizable. It would have been obvious to one of ordinary skill in the art to make the plastic covered metal with the limitations of the rate of elongation and thickness since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

4. Claims 9, 14 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

5. Remarks regarding rejected under 35 U.S.C. 103(a) as being unpatentable over March et al. (U.S. 5,937,521) have been considered but are unpersuasive. Applicant argues the technical field of March is very different from that of the present invention and is therefore considered not to be pertinent prior art. Applicant is arguing the intended use of the instant application is not the same intended use of the March patent. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicant argues the structure of March does not disclose a metal plate covered with a laminate of two different types of plastic films. Examiner respectfully disagrees. In claim 1, Applicant claims a plastics covered metal plate for car body in which one surface or both surfaces of the metal plate are covered with at least two kinds of plastic films whose elongation rates are different from each other. March discloses elongated plastic members (column 2, line 48) where metal (20)

is covered by a plastic shell (18) and a plastic core (12) comprised of suitable thermoplastic resins such as polyolefins, including polyester (column 4, lines 59-67). The reference discloses steel (metal) is coated with the well-known coatings (column 5, lines 44-45) where the plastic members are cut into predetermined lengths (abstract), giving the plastic members different elongations. March discloses metal with one surface covered by two kinds of plastic films whose members are cut into predetermined lengths. One skilled in the art would readily appreciate that different plastic material cut into predetermined lengths have different rates of elongation, where the coating of the plastic layers is equivalent to laminating the plastic layers. Applicant further argues the stick like shape of March is different from the metal plate of the invention. Examiner respectfully disagrees because the metal layer (20) in Figure 2 is considered a metal plate.

Examiner acknowledges Applicants request for rejoinder of non-elected claims 15-18.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence D. Ferguson
Examiner
Art Unit 1774



ELIZABETH MULVANEY
PRIMARY EXAMINER